



PATENT
P57016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SU-JIN HAN et al.

Serial No.: 10/791,854

Examiner: TURNER, Katherine Ann.

Filed: 4 March 2004

Art Unit: 1795

For: SECONDARY BATTERY HAVING AN ENLARGED ELECTROLYTIC
SOLUTION INLET (as amended)

PETITION UNDER 37 CFR §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction request initialized on Paper No. 20071219 mailed on 11 February 2008 and finalized on Paper No. 20080620 mailed on 8 July 2008.

Folio: P57700
Date: 10/8/08
I.D.: REB/XL/rd

STATEMENT OF FACTS

1. On 11 February 2008, the Examiner in paper No. 20071219, imposed a restriction request, requiring Applicant to respectively elect one specie within each of Groups I, II and III;
2. On 11 March 2008, Applicant filed an Amendment & Response under 37 C.F.R. 1.143, provisionally electing species A1 of Group I, covering claims 2 through 13, 15 through 26 and 28 through 37;
3. On 23 April 2008, the Examiner imposed a telephone restriction, requiring Applicant to respectively elect one specie whin each of Groups II and III;
4. On 25 April 2008, Applicant filed an Amendment & Response under 37 C.F.R. 1.143, provisionally electing species B1 of Group II covering claims 8, 23 and 35, species C2 of Group III covering claims 12 through 14; and
5. On 8 July 2008, a non-final Office action was mailed (No. 20080620) examining only claims 1, 2, 4-8, 12-17, 19-23, 26-35 and drawn to the elected species A1 of Group I, species B1 of Group II and species C2 of Group III. In Paper No. 20080620, the Examiner acknowledged Applicant's 11 March 2008 and 25 April 2008 37 C.F.R. 1.143 traversal but finalized the telephone restriction and the restriction

request of 11 February 2008. The Examiner in No. 20080620 submits that the claims which are represented by each species were incorrectly established in the paper No.20071219, and each species however were correctly established by reciting the claim language. In paper No. 20080620, the Examiner therefore finalized the telephone restriction and the restriction request of 11 February 2008 by correctly establishing species A1 of Group I covering claims 2, 17, 29 and 30.

REMARKS

The Examiner maintained the restriction requirement previously imposed in this application.

The requirement for restriction was not withdrawn, but was made final in paper No. 20080620, the applicant respectively files the present Petition to the Commissioner because there is no *serious* burden upon the Examiner in searching species A1 and A2 of Group I, species B1 and B2 of Group II and species C1 and C2 of Group III, and the applicant's invention teaches a single invention.

The applicant has amended independent claims 14 and 27 by adding a definition of electrolytic solution inlet and thus claims 14 and 27 have similar definitions compared to claim 1. The applicant therefore discussed the different species included in the independent claim 1 and the dependent claims 2 through 13 depending on claim 1 as an example of traversing the Examiner's restriction requirement in the following paragraphs. The Examiner is requested to be noted that the different species included in the independent claims 14 and 27 and their corresponding dependent claims are similar to the independent claim 1 and the corresponding dependent claims depending on claim 1, therefore, the applicant's arguments stated in the following paragraphs are applicable to independent claims 14 and 27 and the corresponding dependent claims respectively depending on claims 14 and 27.

The applicant respectfully submits that a restriction requirement should not be imposed in this application for the reasons previously stated in the Amendment filed on 11 March 2008 and 25 April 2008, which are incorporated herein by reference thereto.

Restriction to one of the following inventions was required under 35 U.S.C. 121:

Species Group I

Species A1, appears to be claims 2, 17, 29, and 30

Species A2, appears to be claims 3 and 18

Species Group II

Species B1, appears to be claims 8, 23 and 35

Species B2, appears to be claims 9-10, 24-25 and 36-37

Species Group III

Species C1, appears to be claim 11

Species C2, appears to be claims 12 through 14

The applicant has cancelled claims 3, 18 and 30 and thus Species A2 are no longer to be claimed. The applicant cancelled 2, 17 and 29 and incorporated the limitations of claim 2, 17 and 29 respectively into claims 1, 14 and 27. The applicant elected Species A1 now incorporated into claims 1, 14 and 27 and provisionally elected Species B1 and C2 with traverse.

The applicant objects to and traverses the Examiner's restriction requirement on the grounds that the subject matter of the six Species are overlap and must be simultaneously examined in compliance with 37 CFR §1.104(a). In addition, the mandatory fields of search for the six embodiments are coextensive. Finally, it appears that the restriction requirement is being imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

The Examiner stated that the embodiments of Species A1, Species B1-B2 and Species C1-C2 are patentably distinct species. This restriction is improper and contrary to Office policy; the basis for Applicant's traverse is, as follows.

Species A1, Species B1-B2 and Species C1-C2 are five different however firmly related embodiments for a single invention. The discussion is as follows.

Species A1 and Species B1-B2 are three embodiments of the applicant's invention. The applicant amended claim 1 for better definition of the structure of the applicant's novel electrolytic solution inlet and the amended claim 1 further defines the embodiment of Species A1. The amended claim 1 defines a secondary battery including an electrolytic solution inlet having a first area of a first opening on a first surface of the cap plate being different from a second area of a second opening on a second surface of the cap plate, with the first surface of the cap plate and the second surface of the cap plate opposite to and spaced apart from the electrode unit. The amended claim 1 defines that the electrolytic solution has two openings respectively disposed on two surfaces of the cap plate with the two openings having different areas, and the first area is smaller than the second area. The applicant no longer claims the embodiment as shown in FIG. 4. The difference of the area of the two openings is the enlarged entrance for the electrolytic solution inlet. The applicant's electrolytic solution inlet of the secondary battery defined by claim 1 may have a structure as shown in FIG. 3 (defined by claim 1), a structure as shown in FIG. 5 (defined by claim 8) or a structure as shown in FIG. 6 (defined by claim 9).

The fact that the Examiner has examined the genus claim 1 on the merits in paper No. 20080620, proves that the Examiner has performed a successful searching without any burden. In other words, in order to determine the patentability of the genus claim 1, the Examiner should have simultaneously examined the secondary batteries which have different structures of electrolytic solution inlets. Therefore, there is no serious burden upon the Examiner in searching Species A1 and Species B1-B2.

Species C1-C2 define the relative positions of the second electrode tab, the terminal pin and the electrolytic solution inlet. It could be expected that during the Examiner examining the provisionally elected Species C2, the Examiner has examined the existing relative positions between these three components in the art. In other words, in order to determine claim 12 through 14 (the provisionally elected Species C2), the Examiner has simultaneously examined several secondary batteries which may have different relative positions between the second electrode tab, the terminal pin and the electrolytic solution inlet. Therefore, there is no serious burden upon the Examiner in searching Species C1-C2.

Therefore, there is no serious burden upon the Examiner in searching Species A1, Species B1-B2 and Species C1-C2.

As specifically stated in MPEP § 803, the Examiner must show that the (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B) There must be a **serious burden** on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and § 808.02). The Examiner

must prove there is a serious burden on the Examiner. It is respectfully submitted that there would not be a serious burden upon the Examiner in searching the invention of Species A1, Species B1-B2 and Species C1-C2.

Moreover, the Examiner fails to either aver the existence of a serious burden, or even that Applicant's are classified in different subclasses, or the fields of mandatory search are different. In point of fact, the Examiner fails to identify any classification for the individual species. There is therefore, on the record of this prosecution history, neither factual evidence which would support a naked allegation of any reason for this requirement under 37 CFR §1.146, nor factual basis for an evidentiary inference that would justify the imposition of this requirement. In short, this imposition of a requirement for an election of species merely delays a timely completion of the examination without concomitant benefit to the Applicant. Its withdrawal is respectfully requested. Such action is respectfully urged.

In conclusion, Applicant objects to and traverses the election requirement on the grounds that the subject matter of the six species overlap. In addition, the mandatory fields of search for the six embodiments are coextensive. Furthermore, the Examiner has successfully searched the six embodiments during the examination of genus claim 1 and provisionally elected Species C2 without any burden. Finally, it appears that the election requirement is being imposed merely for administrative convenience and such a basis for imposition of such a requirement has been prohibited in previous decisions of the Commissioner.

Applicant respectfully traversed the final restriction requirement imposed in paper

No.20080324. The applicant objected to and traversed the restriction requirement on the grounds that the restriction requirement appears to have been imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

Firstly, the Examiner has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner must examine the application on the merits, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the restriction request under 37 CFR §1.142, and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement cannot be made final according to MPEP §706.07.

Secondly, the Examiner on page 3 of paper No. 20080620, states that “there is serious burden upon the Examiner in searching the invention, because these is a different field of search for the species.” The applicant respectfully disagrees with the Examiner assertion because the fact that the Examiner has examined the genus claim 1 on the merits in paper No. 20080620 proves that the Examiner has performed a search without any burden. In other words, in order to determine the patentability of claim 1 and the provisionally elected Species C2, the Examiner has simultaneously

examined several different electrolytic solution inlets of the secondary batteries which may have different structures. Therefore, there is no serious burden upon the Examiner in searching the invention.

As discussed above, Species A1, B1-B2 and C1-C2 are five embodiments of the applicant's invention and have firm relationships between each other and are not distinct inventions. Therefore, the Examiner "must discuss such relationships and provides reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction". See MPEP 808.01(a). The Examiner in the preceding office actions failed to mention or discuss such relationships. Therefore, the Examiner is respectfully requested to be noted that Species A1, B1-B2 and C1-C2 are related and are not distinct inventions.

Thirdly, MPEP §806.03 states that:

"Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition" (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? That fact that Applicant's claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant's inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

CONCLUSION

The fact that Species A1 of Group I, B1-B2 of Group II and C1-C2 of Group III of pending claims are identified by the Examiner, does not create an evidentiary inference that the pending claims define three distinct inventions which have attained separate status in the art. Rather, these six Species are six different embodiments of a single invention and these embodiments should be included in the mandatory field of search of Applicant's single invention. It is rare the a single claim may be thorough searched within a single subclass.

The obsession of the Examining staff with the possibility that the pending claims may be directed to different species falling into different field of search, may be a basis which mandates a finding of a requirement of serious burden upon the Examiner in searching the different species from the groups, is a cause for concern because the Examiner has conducted an successful searching during the examination of the genus claim 1 and the provisionally elected Species C2, as was demonstrated by the Examiner's examinations as stated in Paper No. 20080620.

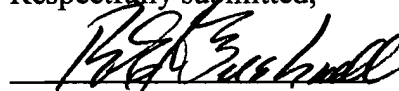
Withdrawal of this requirement is thus respectfully urged.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Insist that the restriction requirement of Paper No. 20080324 be withdrawn;
- B. Examine all of Applicant's claims on the merits without further undue process; and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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